

Remarks

Claim 20 has been amended. It no longer depends from claim 3 and incorporates the limitations of the claims from which it previously depended. New claims 21-26 have been added to the specification. No new matter has been added by amendment. Reexamination and reconsideration of the claims are requested.

Rejection under 35 USC 102(b)

Claims 1, 3, 5, 8, 10-12 and 14-19 are rejected under 35 USC 102(b) as anticipated by Torii et al. (US 5,972,862). Applicants respectfully traverse the rejection.

Torii claims compositions containing a fluoride containing compound, a water soluble organic solvent, an inorganic or organic acid, and a quarternary ammonium salt or organic carboxylic acid ammonium salt. When an organic carboxylic acid ammonium salt is used, the composition must also contain a surfactant. In contrast, Applicants claim an aqueous composition consisting essentially of the admixture of an acid buffer, a polar organic solvent miscible in water, a fluoride, and water where the composition has a pH of 3 to 6 and is free of glycols. The standard for lack of novelty is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all the elements.

Applicants submit that the cited reference lacks the "buffering" element of the claimed invention. In prior actions the Examiner proposed that any system with an acid and a base contained a buffer. Applicants submit that this is not the case. Buffer is a term of art. A technical description for creating a buffer is given in Exhibit 1 of the enclosed Declaration. Buffer solutions are understood to have a practical capability of maintaining their pH at some fairly constant value even when small amounts of acid or base are added. See enclosures, Chemistry: A Conceptual Approach 2nd Ed., page 561, and Encyclopedia of Chemical Technology, vol. 7, page 712.

Applications are written for those skilled in the art. Examination of an application must be made with reasonableness and a view to whom the application is written. In Ex parte Brewer, 1 USPQ 2d 1906 (BPAI 1986) the

examiner interpreted the claims as containing a never ending substituent group.
In response to the interpretation the Board stated:

We find that this claim construction, though literal, is not reasonable and is not how a person of ordinary skill in the art would view the claims.... In our view, the examiner's claim construction, though possible, is not reasonable and is incorrect.

The Board of Appeals and Interference specifically upheld a standard of reasonableness in the interpretation of claims, where that interpretation is based on how one skilled in the art would understand the claim. In this case buffers are well known and have a practical usefulness when a situation requires that a composition maintain a stable pH.

The Torii reference makes no mention of a buffer or the need to maintain the pH of the claimed cleaning solutions. The Torii formulations are not inherently able to maintain a stable pH when a small amount of base is added (see page 3 of Exhibit 1 in the enclosed Declaration).

In the Declaration accompanying this response, Applicants have prepared examples 1-5 from the Torii reference and an example of a buffered composition as claimed in the present invention. One can see quite clearly the difference between a buffered composition and compositions that simply contain an acid and a base.

Applicants discuss in the specification the need to provide a composition within a specific pH range in order to optimize performance and minimize corrosion of sensitive metals. In order to maintain this efficacy the compositions of the present invention contain a buffer. There is no disclosure in Torii that recognizes the use of a buffer and its attendant advantages either explicitly or under the doctrine of inherency. Applicants submit that because of the lack of identity between the cited reference and the claimed invention, when interpreted based on how one skilled in the art would understand the claims, there is no support for a rejection under 35 USC102(b).

Rejection Under 35 USC103(a)

Claim 18 is rejected under 35 USC103(a) in view of Small (US 6,117,783). Applicants respectfully traverse. For the reasons stated above, Torii fails to teach either explicitly or impliedly Applicants' claimed invention containing a buffer. Small, which is drawn to chemical mechanical polishing composition, is cited for the purpose of showing the use of gallic acid and catechol as corrosion inhibitors. Small, however, does not provide teachings that remedy the shortcomings of Torii. There is nothing in either reference to suggest to one skilled in the art the combination of a corrosion inhibitor with a buffered cleaning composition. Applicants request the withdrawal of the rejection of claim 18 under 35 USC 103(a).

Rejection Under 35 USC 103(a)

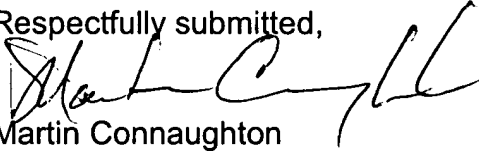
Claims 1-17 are rejected under 35 USC 103(a) as unpatentable over Torii in view of Ward et al. (US 5,571,447). Applicants submit that they have clearly shown the shortcomings of the Torii reference. A combination with Ward will not remedy those shortcomings. Torii fails to provide any teachings related to buffered cleaning compositions. Ward also fails in this regard. In addition as Applicants pointed out previously, Ward requires from 60 to 85% by weight of a glycol. Applicants specifically disclaim glycols. Ward requires a very specific formulation to obtain the results desired. This combination is specifically excluded by Applicants. One cannot pick and choose among the elements of a reference without regard for all that is taught. In addition, Applicants show in example 2 of the specification that compositions containing glycols do not work as effective strippers.

Applicants submit that absent a specific teaching from either cited reference showing a buffered system, there is no basis for maintaining a rejection under 35 USC 103(a).

Conclusion

Claim 20 was amended. New claims 21-26 were added. Withdrawal of all rejections is requested. Allowance at an early date is solicited.

Respectfully submitted,



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